

### REMARKS

Claims 5-6, 10, 25, and 29-33 are canceled without prejudice to their continued prosecution in a continuation and/or divisional application.

The amendments to claims 1, 8, 9, 19, 22, 24, 26, 36 are fully supported by canceled claims 5, 10, and 25 and by the description in the specification (e.g., page 11, line 32 to page 12, line 10; page 19, lines 7-21; page 26, lines 8-13; page 28, lines 13-20 and 25-29; page 29, lines 5-8; FIGS. 7, 13, and 18; etc.).

Claim 37, which the Examiner indicated to contain allowable subject matter, has been rewritten in independent form to incorporate the recitations of its base claim and intervening claim.

The dependency of claim 36 was amended in view of the cancellation without prejudice of base claim 29.

No new matter has been added. Upon entry of this Response, claims 1, 3-4, 7-9, 11-24, 26-28, and 36-38 are present and active in the application.

#### **Claim Rejections – 35 U.S.C. § 102**

1. The rejection of claims 5, 6, 25, and 29 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, as being obvious over *Conn et al.* (U.S. Patent No. 6,438,414 B1) has been rendered moot by the cancellation without prejudice of these claims. Accordingly, withdrawal of this ground of rejection is respectfully requested.

2. The rejection of claims 1, 4, 7, 13, 15, 17-18, 24, 28, and 36 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, as being obvious over *Conn et al.* has been obviated by amendment. *Conn et al.* does not teach or suggest a "first electrode part" comprising "a first collection material" that has "a contact area with the skin of between about 0.01 and about 25 mm<sup>2</sup>," as required by each of independent claims 1 and 24 as presently written.

The range of contact areas recited in each of independent claims 1 and 24 ("between about 0.01 and about 25 mm<sup>2</sup>") is defined in relation to a "first collection material." By contrast, the 0.3 to 1.0 cm<sup>2</sup> range described in *Conn et al.* (col. 18, lines 4-6) refers to an electrode area rather than to a contact area between a collection material

and the skin. Indeed, the iontophoretic electrodes described in *Conn et al.* do not directly contact the skin. Rather, as best shown by FIG. 1B of *Conn et al.*, a collection material (e.g., hydrogel pad 8) is interposed between the electrodes (12 and 14) and the skin, such that electrical potential or current is applied to the skin through the hydrogel pad 8 (col. 15, lines 27-34).

In the assemblies described in *Conn et al.*, a collection insert 52 (e.g., a hydrogel pad or disk) contacts the skin through an opening 62 in mask layer 58 (e.g., FIG. 3; col. 6, lines 42-43; col. 10, lines 49-51; col. 21, lines 7-38). As shown in FIG. 8C, the opening 62 in mask layer 58 is 0.438 inch in diameter (col. 27, lines 19-20). Based on this diameter, the area of the circular opening 62 in mask layer 58—in other words, the contact area of the collection insert 52 with the skin—can be calculated as shown below:

$$\text{Area} = \pi \times r^2 = \pi \times (2.54_{\text{cm/inch}} \times 0.438_{\text{inch}} \div 2)^2 = 0.309\pi = 0.97 \text{ cm}^2 = \underline{97 \text{ mm}^2}$$

As shown by the above calculation, the contact area between collection insert 52 and the skin is 97 mm<sup>2</sup>—an area that lies well outside the range required by each of independent claims 1 and 24. Moreover, *Conn et al.* contains no teaching or suggestion of any contact area between a “collection material” and the skin that is “between about 0.01 and about 25 mm<sup>2</sup>,” as required by each of independent claims 1 and 24.

Accordingly, for at least these reasons, Applicants respectfully submit that the claimed invention is neither anticipated by nor would have been obvious in view of *Conn et al.* Withdrawal of this ground of rejection is, therefore, respectfully requested.

3. The rejection of claims 19, 20, and 22 under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, as being obvious over *Kim et al.* (U.S. Patent No. 6,736,777 B2) has been obviated by amendment. *Kim et al.* does not teach or suggest a “first path-forming electrode part” comprising “a purified water/ion-conductive material” that has “a contact area with the skin of less than about 25 mm<sup>2</sup>,” as required by independent claim 19 as presently written.

The range of contact areas recited in independent claim 19 (“less than about 25 mm<sup>2</sup>”) is defined in relation to a “purified water/ion-conductive material.” By contrast, the 0.3 to 1.0 cm<sup>2</sup> range described in *Kim et al.* (col. 16, lines 65-67)—analogous to the

range described in *Conn et al.* (assigned to the same assignee as *Kim et al.*)—refers to an electrode area rather than to a contact area between a collection material (e.g., the recited “purified water/ion-conductive material”) and the skin.

*Kim et al.* contains no teaching or suggestion of any contact area between a collection material such as a “purified water/ion-conductive material” and the skin that is “less than about 25 mm<sup>2</sup>,” as required by independent claim 19.

Accordingly, for at least these reasons, Applicants respectfully submit that the claimed invention is neither anticipated by nor would have been obvious in view of *Kim et al.* Withdrawal of this ground of rejection is, therefore, respectfully requested.

#### **Claim Rejections – 35 U.S.C. § 103**

1. The rejection of claims 10 and 32 under 35 U.S.C. § 103(a) as being unpatentable over *Conn et al.* in view of *Avrahami et al.* (U.S. Patent Publication No. 2004/0230227 A1) has been rendered moot by the cancellation without prejudice of these claims. Accordingly, withdrawal of this ground of rejection is respectfully requested.

2. The rejection of claims 3, 8-9, 11, and 26-27 under 35 U.S.C. § 103(a) as being unpatentable over *Conn et al.* in view of *Avrahami et al.*, the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Conn et al.* in view of *Glikfeld et al.* (U.S. Patent No. 5,279,543), and the rejection of claims 12 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Conn et al.* in view of *Ackerman* (U.S. Patent Publication No. 2003/0208114 A1) have been obviated by amendment.

Claims 3, 8-9, 11, 12, 14, and 16 depend directly or indirectly from independent claim 1; claims 26 and 27 depend directly or indirectly from independent claim 24. However, as noted above, *Conn et al.* fails to teach or suggest all of the elements of independent claims 1 and 24. Moreover, the deficiencies of *Conn et al.* are not remedied by *Avrahami et al.*, *Glikfeld et al.* and/or *Ackerman*, which likewise do not teach or suggest all the elements of independent claims 1 and 24.

For at least these reasons, Applicant respectfully submits that the claimed invention is neither anticipated by nor would have been obvious in view of these

references, individually or in combination. Accordingly, withdrawal of all grounds of rejection is respectfully requested.

#### **Allowable Subject Matter**

The allowance of independent claim 38 is noted with appreciation.

The Examiner's indication that claims 21, 23, and 37 contain allowable subject matter is likewise noted with appreciation.


In accordance with the Examiner's suggestion, claim 37 has been rewritten in independent form to include the recitations of its base claim and intervening claim. In addition, Applicants respectfully submit that claims 21 and 23, which depend directly or indirectly from independent claim 19, are allowable in their present form in view of the amendments to their base claim.

#### **Conclusion**

In view of the Amendment and Remarks set forth above, Applicants respectfully submit that the claimed invention is in condition for allowance. Early notification to such effect is earnestly solicited.

If for any reason the Examiner feels that the above Amendment and Remarks do not put the claims in condition to be allowed, and that a discussion would be helpful to advance prosecution, it is respectfully requested that the Examiner contact the undersigned agent directly at (312)-321-4257.

Respectfully submitted,

  
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